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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,149	08/22/2003	Stephen J. Bisset	09623C-013510US	8707
20350 7590 03/21/2008 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER NGUYEN, KIMHUNG T				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/646,149

**Applicant(s)**

BISSET, STEPHEN J.

**Examiner**

KIMNHUNG NGUYEN

**Art Unit**

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/26/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-6, 9-26 and 30-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, 9-26 and 30-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This application has been examined. The claims 1, 3-6, 9-15 and 24-26 and 30-32 are pending. The examination results are as following.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 9-10 and 12-15 and 25-26 and 30-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Schein et al. (US 6,075,575).

Regarding claim 1, Schein et al. discloses in fig. 2, a controlled display system comprising: a video display (television screen, see col. 4, lines 16-17); a video controller (20) coupled to the video display and being responsive to an input (cursor controller, see col. 4, lines 36-37); a remote unit (2); a pointing device (cursor or pointing device, see col. 4, lines 35-36, mounted on the remote unit (2), the pointing device being capable of generating a signal corresponding to motion by an operator on the pointing device in two directions and providing the signal corresponding to the motion to the input (see col. 5, lines 12-33), wherein said motion by an operator on the pointing device correlates with a cursor movement in said video display (see controlling a cursor, see abstract), the two directions including a first direction (selection function) and a second direction (selection values); the video controller being configured to

display a menu (see col. 5, lines 12-15), said menu including volume and channel (see col. 4, lines 59-60 and fig. 4B) and to vary a value of a selected function in response to a signal generated which corresponds to motion by the operator on the pointing device in the first direction (see fig. 4A, see col. 9, 17-36), and to select an aspect of a selected menu item in response to a signal generated which corresponds to motion by the operator on the pointing device in a second direction (see cursor control for various functions such as changing channel , operating a VCR see col. 4, lines 17-33), wherein said menu items are vertically arranged on said display; and selection of a menu item activates a horizontal display corresponding to values of the selected menu item (see fig. 8A).

Regarding claim 3, Schein et al. discloses a deactivation of said pointing device select a value for a selected function (see channel 8, fig. 4B)

Regarding claim 4, Schein et al. discloses further comprising a pointing surface (pointing device should have an pointing surface) on the pointing device (cursor controlling), connected to the pointing surface, for detecting contact with the pointing surface and, responsive thereto, sending an activation signal to the video controller (20); and the video controller being configured to display the menu in response to the activation signal as discussed above.

Regarding claim 9, Schein et al. discloses in fig. 7, the pointing device cursor is mounted in a remote control unit (2), and further comprising a wireless transmitter (RF) mounted in the remote control unit (2); and a wireless receiver coupled to the video controller (see fig. 3, col. 4, lines 64-67 and 1-5).

Regarding claim 10, Schein et al. discloses in fig. 2, a remote control (2) and display system comprising a video monitor including a video display (screen as discussed above); a

video controller (20) coupled to the video display and being responsive to an input; and a wireless receiver coupled to the video controller (20); a remote control unit (10) including a pointing device (touch panel 11), capable of generating a signal corresponding to motion (see controlling a cursor, see abstract) by an operator on the pointing device in two directions and providing the signal corresponding to the motion to said input, the two directions including a first direction and a second direction (see col. 7, lines 1-2), wherein said motion by a operator on said pointing device correlates with a cursor movement in said video display; and a wireless transmitter mounted in said remote control unit; said video controller being configured to display a menu, and to select among functions on said menu in response to a signal generated which corresponds to motion by the operator in the first direction and to vary a value of a selected function in response to a signal generated which corresponds to motion by the operator in a second direction (see figs. 4A-4B, see co. 4, lines 33-45), wherein the motion in the first direction is a movement by the operator on the pointing device and the motion in the second direction is another movement by the operator on the pointing device (see figs 4A-4B, see control function, and select values with channel or volume), wherein said menu items are vertically arranged on said display; and selection of a menu item activates a horizontal display corresponding to values of the selected menu item (see fig. 8A).

Regarding claims 12-15, Schein et al. discloses the motion by the operator on the pointing includes motion by the operator relative to a pointing surface of the pointing device, the pointing device comprises sliding motion on the pointing device (see scrolling 120, fig. 44B).

As to claim 24, Schein et al. discloses in fig. 2, a controlled display system comprising:

a video display (television screen, see col. 4, lines 16-17); a video controller (20) coupled to said video display and being responsive to an input (cursor controller, see col. 5, lines 36-37); a remote unit (2); a pointing device (cursor controller), mounted on said remote unit, said pointing device being capable of generating a signal corresponding to motion by an operator on said pointing device in two directions (selection functions and selection values) and providing said signal corresponding to said motion to said input, wherein said motion by an operator on said pointing device correlates with a cursor movement in said video display, said two directions including a first direction and a second direction (selection functions and selection values such as changing channels and changing volume, see col. 4, lines 51-63); said video controller being configured to display a menu, said menu including a plurality of functions including at least one of volume and channel, and to select among items on said menu in response to a signal generated which corresponds to motion by the operator on said pointing device in the first direction, and to select an aspect of a selected menu item in response to a signal generated which corresponds to motion by the operator on said pointing device in the second direction, said aspect including at least one of channel number and amount of volume (see col. 4, lines 51-63).

Regarding claims 25-26 and 30-32 are rejected as the same claims 1, 10 and 11.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (US 6,075,575) in view of Lee et al. (US 5,545,857).

Regarding claim 5, Schein et al. does not disclose the pointing device is touchpad. Lee discloses in fig. 7, the pointing device (11) is a touchpad.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the pointing device is touchpad for selecting the function of the remote controlled apparatus as taught by Lee et al. into the system of Schein et al. for producing the claimed invention because this would utilize as predetermined input means for inputting an instruction for selecting the function of the remote-controlled apparatus (see Lee et al., col. 6, lines 43-45).

Regarding claim 6, Schein et al. does not disclose a tap on said touchpad, and sending an additional control signal in response to said tap.

Lee discloses an inherent tap on said touchpad (because Lee discloses a touch panel may have a tap), and sending an additional control signal in response to said tap.

Regarding claim 11, Schein et al. discloses in fig. 2, a remote control and display system comprising a video monitor including a video display; a video controller (20) coupled to the video display and being responsive to an input; and a wireless receiver coupled to controller (20); a remote control unit (2) capable of generating a signal corresponding to motion by an operator relative to the pointing device in two directions and providing the signal corresponding to the motion to the input, the two directions including a substantially vertical direction and a substantially horizontal direction, wherein the motion by an operator relative to the correlates with a cursor movement in the video display (as discussed above); and a wireless transmitter

mounted in the remote control unit (2); and the video controller being configured to display a menu (discussed above), and to select among functions on the menu in response to a user input in the substantially vertical direction, causing a horizontal values display for a selected function to be activated, and move an indicator horizontally along the horizontal value display in response to a user input in the substantially horizontal direction and to select a currently indicated value by the user.

However, Schein et al. does not disclose the operator relative to the touchpad and to select a current indicated value upon termination of contact with the touchpad by the user.

Lee et al. discloses in fig. 7, a remote control including a touchpad (11) for selecting the function of the remote controlled apparatus (see col. 6, lines 42-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the touchpad for selecting the function of the remote controlled apparatus as taught by Lee et al. into the system of Schein et al. for producing the claimed invention because this would utilize as predetermined input means for inputting an instruction for selecting the function of the remote-controlled apparatus (see Lee et al., col. 6, lines 43-45).

#### ***Response to Arguments***

6. Applicant's arguments filed on 12/26/07 have been fully considered but they are not persuasive.

Applicant argues that "The independent claims have been amended to clarify that movement in one direction selects from among "a plurality of" functions. Schein does show a roller 20, which the office action characterizes as a pointing device, which selects among items in a menu by movement in a first direction (up/down). However, it shows using the roller to



select channels. It does not show moving the roller in another direction to select another function of a plurality of functions other than channels, such as volume". Examiner respectively disagrees because Schein discloses that the menu including volume and channel, and to select among a plurality of function (see fig. 8A).

*Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KIMNHUNG NGUYEN whose telephone number is (571)272-7698. The examiner can normally be reached on MON-FRI, FROM 8:30 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe can be reached on (571) 272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kimnhung Nguyen

March 16, 2008

/Richard Hjerpe/

Supervisory Patent Examiner, Art Unit 2629

